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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,264	11/12/1999	KUNHIKO MIWA	JA9-98-171	1450
26582	7590	03/06/2008		
HOLLAND & HART, LLP P.O BOX 8749 DENVER, CO 80201			EXAMINER PYZOCHA, MICHAEL J	
			ART UNIT 2137	PAPER NUMBER
			MAIL DATE 03/06/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/439,264

Applicant(s)

MIWA ET AL.

Examiner

MICHAEL PYZOCHA

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Page No./Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
- Page No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 35-41 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/2007 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 35-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (herein after AAPA) in view of Linnartz (US 6209092).

As per claims 35 and 38, AAPA discloses a method or recording digital data onto a medium using a copy mark and additional information, said method being executed by a video driver card, comprising the steps of: detecting from digital data and additional information that may be electronically embedded in said digital data, said additional information being 2-bit digital data (see specification page 2 lines 14-33); If said additional information is detected performing access control for said digital data using said additional information, said access control being performed in accordance with a content of said additional information and including embedding a copy mark into said digital data (see specification page 2 lines 22-27); recording the digital data, additional information, and copy mark onto a writable medium so as to control subsequent copying or playback of said digital data recorded on said writable medium by way of said additional information (see specification page 2 lines 22-34).

AAPA fails to explicitly disclose the well-known concept of scrambling the content recorded on the writable medium.

However, Linnartz teaches scrambling of data recorded on a writable medium (see column 11 lines 53-56).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to scramble the digital data of AAPA.

Motivation to do so would have been to include additional protection for the data (see Linnartz column 11 lines 53-56).

As per claims 36 and 39, the modified AAPA and Linnartz system discloses the copy mark indicates whether copying/recording of said digital data is to be stopped continued after the addition of the copy mark (see AAPA page 2 lines 22-34).

As per claims 37 and 40, the modified AAPA and Linnartz system discloses a method of performing playback control of digital data that is both scrambled and embedded with additional information, said method being executed by a video driver card, comprising the steps of: reading said scrambled digital data from said medium; descrambling said digital data to detect said additional information embedded in descrambled digital data, said additional information being 2-bit digital data (see AAPA page 2 lines 14-20 and 35-46 and Linnartz column 11 lines 53-56); determining contents of said detected 2-bit digital data; if said contents has a particular value and a copy mark is not present, adding a copy mark and controlling playback of said

descrambled digital data using said copy mark (see AAPA page 2 lines 14-46).

As per claim 41, the modified AAPA and Linnartz system discloses the copy mark indicates whether copying/recording of said digital data is to be stopped continued after the addition of the copy mark (see AAPA page 2 lines 22-34).

Response to Arguments

5. Applicant's arguments with respect to claims 35-41 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Linnartz and Oshima teach methods of controlling data using additional information and copy marks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PYZOCHA whose telephone number is (571)272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJP

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2137